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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/833,319	04/12/2001	Mototaka Iwata	MIZ33	3494
6980	7590	01/20/2004	EXAMINER	
TROUTMAN SANDERS LLP BANK OF AMERICA PLAZA, SUITE 5200 600 PEACHTREE STREET, NE ATLANTA, GA 30308-2216			DUONG, THANH P	
			ART UNIT	PAPER NUMBER
			3711	18
DATE MAILED: 01/20/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/833,319

Applicant(s)

IWATA ET AL.

Examiner

Tom P Duong

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 8,10,11 and 16-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8,10,11 and 16-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 8, 10-11, and 14-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 8, lines 14-15, It is not clear how the recess portion is "surrounded" by a thick portion of the sole part. It is best understood by examiner that the thickening sole portion has a recess into the sole portion.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 8, 11, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al. (5,255,918). Regarding claims 8 and 16, Anderson discloses a golf club head comprising: a front striking face 21, a rear arcuate body wall 43 (a cavity back structure) wherein the sole portion has a thicker portion than its top edge, a space 41 allows rearward deflection of the striking face 21, a re-entrant recess 42 (a recess

portion at the rear surface of the rear component). With respect to the effective face area and effective deflection length, USGA has no restriction on the dimensional limits of the striking face; thus, golf club manufacturer can fabricate the striking face with any size just as long as the club head does not exceed 350cc. Thus, the striking face area in view of Anderson can be optimized and enlarged to maximize the sweet spot area. In addition, the striking face area for each club head number in a club set is varied; thus, its corresponding effective face area is varied with respect to the club head number. Thus, it would have obvious in view of Anderson to one having ordinary skill in the art to optimize the striking face area to maximize its effective face area and effective deflection length to maximize the sweet spot and improve the COR. Regarding claim 11, Anderson discloses a concave rear body wall 43 with forward periphery top and bottom edges to communicate with the front striking face 21.

3. Claims 10 and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al. (5,255,918) in view of Chen (5,683,310). Anderson does not disclose a front portion having a concave part provided in the center. Chen teaches a face with shoulder 211 forming a "concave" front-part component and the shoulder serves to reinforce the structural strength of the periphery of the face. Thus, it would have been obvious in view of Chen to one having ordinary skill in the art to modify the face of Anderson with a face having shoulder 211 of Chen in order to provide structural reinforcement of the face periphery.

4. Claims 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al. (5,255,918) in view of Japanese Publication Number 08-168541 (JPN '541). Anderson does not disclose expressly the face thickness and the characteristics of the striking face. JPN '541 teaches it is important to fabricate a club head with a high strength face material with thickness less than 3 mm in order to provide the striking face with improved bending stress and elasticity. Such characteristics improved face deformation, reduce energy loss, and improved flight performance. Thus, it would have been obvious in view of JPN '541 to one having ordinary skill in the art to fabricate the club head of Anderson with the striking face of JPN '541 in order to provide a golf club with improved flight performance.

### ***Response to Arguments***

Applicant's arguments with respect to claims 8-11 and 14-15 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tom P Duong whose telephone number is (703) 305-4559. The examiner can normally be reached on 8:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on (703) 308-1513. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

Tom Duong

  
GREGORY VIDOVICH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700